

(20, Figure 1) and a dog biscuit (60, Figure 2) presumably made of conventional biscuit constituents.

As the Examiner concedes, Stonoga et al. fails to teach that the card itself is suitable for ingestion by the pet, and further is silent as to the use of rawhide. The Examiner must admit that these are very significant deficiencies on the part of Stonoga, and contribute to large measure to Applicant's point of novelty as claimed. To overcome these significant limitations, the Examiner adds the Swiss Colony reference, which appears to be an edible card for human beings composed of chocolate. Thus, the Swiss Colony reference is not directed to the same field of endeavor, includes no rawhide, and may include an outer wrapper which is not suitable for ingestion. Beck, on the other hand, resides in an edible toy ball for pets, which the Examiner uses to show that rawhide may be manipulated and manufactured in different ways.

It is Applicant's position that the Examiner has failed to meet the burden of establishing *prima facie* obviousness, primarily because there is no showing whatsoever from the prior art to suggest the combination used by the Examiner for the purposes of rejection. The Federal Circuit reasons in Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc., 73 F.2d 1085, 1088-89, 37 USPQ2d 1237, 1239-40 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996), that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop of the prior art, would have reasonably expected to use the solution that is claimed by the Applicant. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc., 73 F.2d at 1087, 37 USPQ2d at 1239 (citing W.L. Gore & Assoc., Inc. v. Garlock Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-313). The

CAFC also requires the PTO to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Claims 2 and 4 stand rejected over the combination applied to claim 1, and further in view of DE 4010003A1. applicant's response to this rejection is based on the response to the rejection of claim 1, namely, that there is no showing *from the prior art* to teach the combination of references used by the Examiner. Although DE 4010003A1 teaches a hinge of edible material, such as chewing gum, it is taken from yet a different field of endeavor and there is no suggestion to use it in the way claimed by Applicant. Claim 3 stands rejected §103 over the references applied to claims 2 and 4, and further in view of Bach ('418). Again, there are no teachings or suggestions from these references which would result from the combination claimed by Applicant.

Based upon the foregoing, Applicant believes the claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone and facsimile numbers provided.

Respectfully submitted,

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